

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN PAUL MARCADE,
ANTHONY WEST, and
FREDERICK W. KORNAHRENS

Appeal 2007-2500
Application 09/777,274
Technology Center 3700

Decided: September 24, 2007

Before WILLIAM F. PATE, III, HUBERT C. LORIN, and ANTON W. FETTING, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Final Rejection of claims 67-72, and 74-82. These are the only claims remaining in the application.

Appeal 2007-2500
Application 09/777,274

We have jurisdiction under 35 U.S.C. §§ 134 and 6.

The claimed invention is directed to a two part device for repairing a patient's vasculature. The first part is a body with a bifurcated end that includes a first and second leg. The first leg is longer than the second leg. The second part of the device is an extender configured to mate with the first leg.

Claim 67, reproduced below, is further illustrative of the claim subject matter.

67. A device for repairing a patient's vasculature including a first section and second and third sections bifurcating therefrom, comprising:

a body, the body having a superior end portion and a bifurcated inferior end portion defining a first leg and a second leg, the first leg being longer than the second leg, wherein the body is configured so that the first leg extends into one of the second and third sections of vasculature and the second leg terminates in the first section of vasculature; and

an extender in the form of a graft, the extender configured to mate with the first leg after the body is placed in vasculature.

The references of record relied upon by the Examiner are:

Martin	US 5,653,743	Aug. 5, 1997
Goicoechea	US 5,800,508	Sep. 1, 1998

Claims 67-72 and 74-82 stand rejected under 35 U.S.C. § 102(e) as anticipated by Martin.

ISSUE

The sole issue for our consideration on appeal is whether the Appellants have established that the Examiner erred in rejecting 67-72 and 74-82 as lacking novelty over Martin.

Martin discloses a graft for repairing a person's vasculature which has a first section and second and thirds sections bifurcating therefrom. The body 2, 19 has a first leg 8 and second leg formed by bottom opening 6. The first leg 8 is shorter than the second leg 6. An extender 18 in the form of a graft is configured to mate with the first leg after the body 2 is place in vasculature. The diameter of the first leg 8 is inferred as being from 4mm. - 8mm. See col. 2, l. 66. The diameter of leg 6 at the outlet is given as 4 mm.- 6mm. See col. 2, l. 63. The extender or straight tube graft 18 is presumed to be the diameter of graft 8, i.e., from 4mm. - 8mm. See Figure 5.

PRINCIPLES OF LAW

The prior art may anticipate a claimed invention, and thereby render it non-novel, either expressly or inherently. *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 907 (2003). Express anticipation occurs when the prior art expressly discloses each limitation (i.e., each element) of a claim. *Id.* In addition, “[i]t is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it.” *Id.* Inherency looks to whether a matter is necessarily present in the prior art; it “may not be established by probabilities or possibilities.” *Scaltech Inc. v. Retec/Tetra, L.L.C.*, 178 F.3d 1378,

Appeal 2007-2500
Application 09/777,274

1384 (Fed. Cir. 1999). Thus, [a] claimed invention may be inherently anticipated by a prior art disclosure if the claimed invention necessarily or inevitably flows from the prior art. *See, e.g., Cruciferous Sprout*, 301 F.3d at 1349, 64 USPQ2d at 1206 ; *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999).

ANALYSIS

As noted above, the diameter of the leg that has an outlet at 6 overlaps with the diameter of the shorter tube graft of second leg 8. The second leg 8 presumably has the same diameter as the extender 18. See Figure 5. Accordingly, for some embodiments of the graft of Martin, the extender would have the same diameter as the outlet 6.

According to Appellants' argument in the Reply Brief, "configured" means to form or shape. Thus, "configured to mate" is construed in this context as being the same shape and diameter. Inasmuch as Martin discloses that some embodiments have the extender of the same diameter as the longer leg, we are constrained to find that the extender is "configured to mate" with the first or longer leg in Martin, at least with respect to these embodiments. In our view, this is merely an example of where a species within the scope of Martin's disclosure anticipates the genus of Appellants' claim 67. *See Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 778 (Fed. Cir. 1985) (holding an earlier species disclosed in the prior art defeats a generic claim). We further note that claim 67, as we construe it, does not actually require the extender graft to be mating with the first leg, only that it is configured or sized to do so.

Appeal 2007-2500
Application 09/777,274

Additionally, we acknowledge arguments in the Brief directed to whether the graft 18 when placed on outlet 6 in the vasculature would obstruct perfusion. These arguments are not commensurate in scope with the claims. Nothing in the claimed subject matter requires the two parts of Appellants' article be installed in the vasculature. Nor do the claims require the two parts--graft and body--to actually be put together. The claims have been carefully crafted using "configured to" language.

Appellants separately argue claims 70, 82, and 81 in the Brief. With respect to claim 70 the body, i.e., members 1 and 19 of Martin, is shown to have a superior end in the aorta. See Figure 5 of Martin. Nothing in the claimed subject matter limits the body to graft 2 of Martin. Nor, as we mentioned above, does the claim require actual implantation. Accordingly, Martin is seen to anticipate claims 70 and 82. With respect to claim 81, we note that the leg of Martin which ends in opening 6 does have an increasing diameter. See Figure 1. The diameter increases from the inferior to the superior. Therefore, claim 81 lacks novelty over Martin.

CONCLUSION

As noted above, it is our finding of fact that claims 67-72 and 74-82 lack novelty over Martin. The rejection on appeal is affirmed.

Appeal 2007-2500
Application 09/777,274

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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